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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,745	10/27/2003	Kohich Kanaya	244226US2	8851
22850	7590	12/13/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TRAN, NGHI V	
			ART UNIT	PAPER NUMBER
			2151	
			NOTIFICATION DATE	DELIVERY MODE
			12/13/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	Application No. 10/692,745	Applicant(s) KANAYA, KOHICH	
	Examiner Nghi V. Tran	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. This office action is in response to the amendment filed on October 04, 2007. No claims have been amended. No claims have been canceled. Claim 19 has been added. Therefore, claims 1-19 are presented for further examination.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goddard et al., United States Patent Number 6,622,266 (hereinafter Goddard), in view of McCarthy, Jr., United States Patent Number 7,031,009 (hereinafter McCarthy).

4. With respect to claims 1, 4, 7, 10, 13, and 16, Goddard teaches an image processing apparatus [i.e. a plurality of printers and/or other output devices, 106, 108, 110, 112, and/or 114] connected to a network [i.e. enterprise network 104] and operative to perform printing and copying jobs upon a request from a user [see abstract and figs.1-4], said image processing apparatus comprising: an electronic mail transmitting device [i.e. email server 218] configured to transmit an electronic mail

having the thumbnail image data of the first page to a mail address of the user when the job is completed or interrupted [see abstract; figs.1-2; col.2, ll.23 through col.4, ll.63; and col.6, ll.29-34].

However, Goddard does not explicitly show a thumbnail image data generating device configured to generate thumbnail image data of a first page of a job.

In a related art, McCarthy suggests a thumbnail image data generating device configured to generate thumbnail image data of a first page of a job [see abstract and col.1, ll.31-59].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by configuring to generate a thumbnail image data of a first page of a job because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].

5. With respect to claims 2, 5, 8, 11, 14, and 17, Goddard further teaches wherein the mail address is associated with a user code representing a user [fig.2].

However, Goddard does not explicitly show wherein the image processing apparatus is operable when the user code is input and authenticated.

In a related art, McCarthy suggests wherein the image processing apparatus is operable when the user code is input and authenticated [i.e. a user 10 logs in and

selects, enters or is associated with basic capture parameter, col.2, ll.16 through col.4, ll.47].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by operating when the user code is input and authenticated because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].

6. With respect to claims 3, 6, 9, 12, 15, 18, and 19, Goddard does not explicitly show wherein the user code is authenticated by accessing a user code table listing users permitted to request the job.

In a related art, McCarthy suggests wherein the user code is authenticated by accessing a user code table listing users permitted to request the job [col.2, ll.16 through col.4, ll.47].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by accessing a user code table listing users permitted to request the job because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this reason that one of ordinary skill in the art at the time of the invention

would have been motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].

### ***Response to Arguments***

7. Applicant's arguments filed October 04, 2007 have been fully considered but they are not persuasive because of the following: Goddard teaches an image processing apparatus [i.e. a plurality of printers and/or other output devices, 106, 108, 110, 112, and/or 114] connected to a network [i.e. enterprise network 104] and operative to perform printing and copying jobs upon a request from a user [see abstract and figs.1-4], said image processing apparatus comprising: an electronic mail transmitting device [i.e. email server 218] configured to transmit an electronic mail having the thumbnail image data of the first page to a mail address of the user when the job is completed or interrupted [see abstract; figs.1-2; col.2, ll.23 through col.4, ll.63; and col.6, ll.29-34]. However, Goddard does not explicitly show a thumbnail image data generating device configured to generate thumbnail image data of a first page of a job. In a related art, McCarthy suggests a thumbnail image data generating device configured to generate thumbnail image data of a first page of a job [see abstract and col.1, ll.31-59]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by configuring to generate a thumbnail image data of a first page of a job because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been

motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].

8. In response to applicant's arguments that the email server **218** in Goddard is not part of an image processing apparatus, the examiner respectfully disagrees. The Applicant's argument does not commensurate with the scope of the claim. Claims 1, 4, 7, 10, 13, and 16 directly or indirectly recite an electronic mail transmitting device configured to transmit an electronic mail. However, claims 1 and 13 do not recite the limitation of "the email server **218** in Goddard is part of an image processing apparatus" (emphasis added). Further, Goddard discloses the printer configures alert notification for printer **106, 108, 110, 112, and 114** by specifying e-mail address 216 of individuals designated to receive at least one printer alert notifications which that individual is to receive [col.3, ll.45-65]. Therefore, Goddard discloses an image processing apparatus includes the email server **218**.

8. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as show in the above.

9. In response to applicant's argument that McCarthy cant not cure deficiencies in Goddard, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

10. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by configuring to generate a thumbnail image data of a first page of a job because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].



***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V. Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Thursday and every other Friday (6:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Nghi Tran  
Patent Examiner  
Art Unit 2151

December 03, 2007

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**JOHN FOLLANSBEE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**